

Remarks:

Claims 1-8, 12-14, 17, 19-23, and 25 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1, 17, 20, 22, and 23 are amended. Claim 25 is canceled, and claim 26 is added. No new matter is added as support for the amendments is found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

§103 Rejection(s):

Claims 1, 3, 5-8, 13, 14, 17, 19-23, 25, and 26 are rejected under §103(a) as being unpatentable over U.S. Patent No. 6,714,797 to Rautila (hereafter "Rautila") in view of U.S. Patent No. 7,212,785 to Brassil et al. (hereafter "Brassil"). Claims 2, 4, and 12 are rejected under §103(a) as being unpatentable over Rautila in view of well-known prior art. These rejections are respectfully traversed.

It is respectfully noted that the cited references must disclose "each and every element as set forth in the claim, either expressly or inherently" such that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131. Additionally, rejection of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." MPEP §2125.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Rautila is directed to a method for ordering, paying for, and downloading digital products to a mobile device in a cost-effective manner. The mobile device accesses websites listing digital products for sale using a wide area network connection, but downloads the digital

products from hotspot network locations using a short-range network connection. Thus, a user of the mobile device may download large amounts of digital data without incurring telephone or cellular phone charges. See Abstract; column 2, lines 56-67; and column 3, lines 1-38.

Rautila fails to teach or suggest all of the elements recited in the claims. In particular, Rautila fails to teach or suggest “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services provided by a wide area network,” as recited in claim 1, and “comparing the first service to a second service being accessed by a second terminal connected to the short distance wireless network; and providing the first terminal with access to the first service, in response to determining that the first service and the second service are different, wherein the first and second terminals simultaneously access the first and second services, respectively,” as recited in claim 26.

Respectfully, §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

As such, Rautila directly teaches away from claim 1, as amended. Rautila teaches minimizing communication with a wide area network in order to reduce data transmission costs. Claim 1, on the other hand, is directed to expanding communication with a wide area network in order to provide terminals with simultaneous access to services provided by the wide area network.

Since Rautila teaches away from claim 1, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Rautila with any other reference. Accordingly, Rautila should be withdrawn for being an improper reference.

Brassil is directed to a short-range, high-speed wireless network comprising a first device and a second device. The first device communicates with the second device to determine whether the second device has data required by the first device. Upon determining that the

second device has the required data, the first device communicates with a service provider over a long-range, slow-speed network to request permission to download the first data from the second device. If the request is approved, the service provider transmits permission to the first device and transfers the required data from the second device to the first device. See Abstract and column 1, lines 25-59.

Brassil discloses “the required data is transferred from said second communications device to the first communications device, following transmission by the service provider to the first communications device of authorization.” See Abstract, last 5 lines. Brassil also discloses that “[t]his invention relates to local file transfer system and method, and in particular to a system and method for transferring digital data over a high-speed, short-range communications link with the assistance of a slow speed, wide area network communications link. See column 1, lines 5-9.

Thus, the portions of Brassil cited by the Examiner expressly disclose transferring data from a first device in a short distance wireless network to a second device in the short distance wireless network and the first device requesting permission from a service provider. In other words, the first device accesses a data downloading service provided by the second device, and the second device accesses a permission granting service provided by the service provider (wide area network). Nowhere in the cited portions is it disclosed or even suggested that the first device and the second device simultaneously access services provided by the wide area network.

Brassil further discloses “a [Bluetooth] short wireless network can support up to eight simultaneous devices” and “[t]he short-range wireless network uses the wireless networking technology IEEE802.11, and so can accommodate a large number of users. See column 1, lines 18-20; column 3, lines 27-30.

Respectfully, the term “simultaneous,” as disclosed in Brassil, refers to devices connecting to a short distance wireless network and is completely unrelated to connecting to the wide area network. Also, “accommodating a large number of users” refers to the number of devices that are able to connect to the short distance wireless network, not to the number of

devices that are able to connect to the wide area network. Moreover, the mere fact that more than one user can connect to a network does not mean that they connect to the network at the same time.

As such, Brassil fails to cure the deficiencies of Rautila, as Brassil fails to teach or suggest “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services provided by a wide area network,” as recited in claim 1, and “comparing the first service to a second service being accessed by a second terminal connected to the short distance wireless network; and providing the first terminal with access to the first service, in response to determining that the first service and the second service are different, wherein the first and second terminals simultaneously access the first and second services, respectively,” as recited in claim 26.

Further, Brassil directly teaches away from claim 1. Brassil teaches that only the first device accesses a service provided by the wide area network (i.e., permission to download data from the second device) because communication with the wide area network is slow. Claim 1, on the other hand, recites that both the first and the second terminal simultaneously access services provided by the wide area network.

Since Brassil teaches away from claim 1, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Brassil with any other reference. Accordingly, Brassil should be withdrawn for being an improper reference.

The well-known prior art also fails to cure the deficiencies of Rautila, as it fails to teach or suggest “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services provided by a wide area network,” as recited in claim 1, and “comparing the first service to a second service being accessed by a second terminal connected to the short distance wireless network; and providing the first terminal with access to the first service, in response to determining that the first service and the second service are different, wherein the first and second terminals simultaneously access the first and second services, respectively,” as recited in claim 26.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to

combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejections be withdrawn.

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all of the elements recited in claims 1 and 26. Therefore, it is respectfully submitted that claims 1 and 26 are in condition for allowance. Claims 2-8 and 12-14 depend on claim 1 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 17 substantially incorporates the elements of claim 1; therefore, claim 17 and claims 19-23 depending from claim 17 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² “The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner.”

Respectfully submitted,

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